

REMARKS

Applicants have reviewed this Application in light of the Final Office Action mailed May 28, 2010. Claims 17-22 are pending, and Claims 1-16 were previously cancelled. All pending Claims 17-22 were rejected in the Final Office Action. Independent Claims 17 and 22 are amended herein. Applicants respectfully request reconsideration and allowance of all pending Claims 17-22.

Rejections under 35 U.S.C. § 112

Claim 18 was rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have amended claim 18 to remove any ambiguity. Thus, Applicants respectfully request that this rejection be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 17-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Naddell* (U.S. Patent No. 5,613,213) in view of *Seppanen* (U.S. Patent No. 5,903,832).

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Although Applicants do not necessarily agree with the stated rejections, Applicants have amended independent claims 17 and 22 to further distinguish from *Naddell* and *Seppanen*. Applicants submit that *Naddell* and *Seppanen*, whether considered alone or in combination, do not teach the features of the amended claims. For example, amended independent claim 17 recites, in part:

said mobile communication terminal configured to receive user-specified service assessment criteria, and apply the user-specified criteria to the service type lists such that when a particular service type is requested by the user, the top-priority service of the particular service type, as determined according to a particular user-specified criterion, is displayed to the user in a displayed list before the other services of the particular service type, and data that distinguished the top-priority service according to the particular user-specified criterion is displayed at a header end of the displayed list.

Amended independent claim 22 recites similar features.

These amendments are supported in Applicants' specification, e.g., at paragraph 0024 of the printed publication US 2007/0037575:

[0024] In addition, the communication terminal K has a display device 3 which can be linked to all the memories 2A, 2B, 2C. In this case, a user of the communication terminal K can call up the content of a desired list by operating an associated input key on an input device 4. **In addition, the input device 4 allows the user to make a prioritization within one of the lists which are contained in the memories 2A, 2B, 2C, so that a respective header end of one of the lists respectively displays the data for that service which is distinguished by optimum meeting of an assessment criterion which the user has stipulated, whereas the further list entries are preferably noticeable only when the first list entry is not available.**

Thus, the mobile terminal allows a user to specify criteria for assessing services in various service type lists, such that when a particular service type list is displayed, the mobile displays the top-priority service of that list (as determined according to a particular user-specified criterion) first, along with a header end of the displayed list that indicates data that distinguished the top-priority service according to the particular user-specified criterion.

Naddell and *Seppanen* do not teach these features of amended claims 17 and 22. *Naddell* and *Seppanen* do not teach applying a particular user-specified criterion to the services of a service type list to determine a top-priority service, and displaying the top-priority service first in the list, along with a header end of the displayed list that indicates data that distinguished the top-priority service according to the particular user-specified criterion.

The Examiner acknowledged that *Naddell* does not teach prioritizing services according to user-specified criteria, but alleged that *Seppanen* does teach these features at col. 3, lines 49-50 and col. 4, lines 5-9 and 15-20 (see Office Action, page 5, regarding claims 19 and 20). *Seppanen*, col. 3, line 45 to col. 4, line 15 teaches:

It is a second object of this invention to provide a mobile terminal or station to having automatic network selection capability, temporary network selection capability by network name or network capability (e.g., data, fax, e-mail, etc.), and a capability for setting parameters and priorities of networks.

SUMMARY OF THE INVENTION

The foregoing and other problems are overcome and the objects of the invention are realized by methods and apparatus in accordance with embodiments of this invention.

In accordance with an aspect of this invention a mobile station maintains a single, prioritized list of all available networks (i.e., all public, residential, and private networks). Access to the various networks is based on the user's needs. A first type of access is an automatic access, that requires little or no user involvement. A second type of access is to a user-specified network. A third type of access is to a user-specified service (e.g., data, fax, e-mail, etc.) that is supported by at least one of the networks. The mobile station can search for additional networks, and can also search for additional networks that support only a specified type of service, or for a network or networks that support a type of service not supported by networks that are already in the list. All of the networks can be searched at once so that the user can readily make a selection from the single, prioritized network list.

In the first type of access the mobile station selects any available network, wherein the home area network has the highest priority, a second highest priority is reserved for home-type networks, and a third highest priority is reserved for non-home type networks. Any private networks that may be available are not selected unless programmed to do so. The mobile station may indicate the presence of

private networks by displaying a notification and/or outputting an audible signal. If an allowed residential network is available, it is selected automatically. A default network priority order is residential, private, and public.

Applicants do not concede that these passages teach user-specification of assessment criteria for prioritizing the services in a service type list. However, even assuming for the sake of argument that these passage do teach this feature, the passages, along with the remainder of *Seppanen*, do not teach displaying a top-priority service (as determined according to a particular user-specified criterion) first before other services in the list, and displaying at a header end of the displayed list data that distinguished the top-priority service according to the particular user-specified criterion is displayed. *Seppanen* does not teach anything that can be equated with these recited features of amended claims 17 and 22.

Thus, for at least the various reasons discussed above, Applicants submit that amended independent claims 17 and 22 are allowable over *Naddell* and *Seppanen*. Accordingly, Applicants respectfully request allowance of amended independent claims 17 and 22, as well as all dependent claims.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants respectfully submit a Request for Continued Examination (RCE) Transmittal, along with a Petition for Extension of Time. The Commissioner is authorized to charge the fee of \$940.00 required to Deposit Account 50-4871 in order to effectuate this filing.

Applicants believe there are no other fees due. However, should the Commissioner deem that any additional fees are due, including any fees for any additional extensions of time, the Commissioner is hereby authorized to debit said fees from deposit account number 50-4871.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457.2030.

Respectfully submitted,
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Date: 9/9/10

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